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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,700	03/30/2004	Ram Asokan	9314-70	4087
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EXAMINER BATISTA, MARCOS				
ART UNIT 2617		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/812,700

Applicant(s)

ASOKAN, RAM

Examiner

MARCOS BATISTA

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6, 8, 9, 27, 29, 31, 32, 34 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40 is/are allowed.
- 6) ☒ Claim(s) 2-5, 8, 9, 27, 29, 31, 32, 34 and 36-38 is/are rejected.
- 7) ☐ Claim(s) 6 and 39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Action is in response to Applicant's amendment filed on 03/01/2010. Claims 2-6, 8, 9, 27, 29, 31, 32, 34, and 36-40 are still pending in the present application. This Action is made **FINAL**.

Response to Arguments

2. Applicant's arguments filed on 03/01/2010 have been fully considered but they are not persuasive.

After carefully revising the office action pertinent to the present response and remarks, the following main point(s) have been identified:

1) The Applicant at page 10 lines 2-27 of the Applicant's remarks, states that:

Moreover, even if the reply sent by the wireless terminal did notify the VMS that the wireless terminal had received an incoming call, the cited references would nevertheless fail to render Claim 2 obvious because Nasielski's VMS is not "a server that establishes and runs the packet-switched communications session" as recited in Claim 2.

First, Nasielski describes using the Short Message System ("SMS") as a means to send content-filled notifications between a wireless terminal and a voice message server - Nasielski at ¶ 57. Unlike the "messages" described in Koskinen, these notifications are designed to convey meaningful information: "The reply generated by the [wireless terminal] 102 may indicate whether the user accepts or rejects the incoming call." Id. Yet Koskinen explicitly teaches that such information should not be included in its "messages" - See, e.g., Koskinen at ¶ 18."

Second, sending Koskinen's "messages" over a circuit-switched channel would be far more complex than simply using a packet-switched connection. As noted above, such a modification would provide no additional benefits despite potentially requiring substantial changes to the system's software and hardware.

Third, Nasielski describes a system wherein packet-switched communication sessions are terminated when the user opts to participate in a circuit-switched call--when the user accepts the incoming call the packet-switched session is "released" and a circuit-switched connection is established.

Regarding point 1), the reply message sent by the subscriber station in Nasielski's invention to notify the VMS about the acceptance or rejection of an incoming call is intended to reach the server that handles the packet session. It can be seen at

paragraph 57 that Nasielski teaches transmitting a message to the VMS and as consequence of that message, the packet session can be released. This teaching clearly suggests that the PDSN; the server that handles the packet session, will be informed of such message.

The purpose of the maintenance message sent in Koskinen's invention is to indicate to the server that handles the packet session about a packet session setting that will help control the packet session. This message is sent as a result of receiving an incoming call. This message might not carry any information on it, but the message it conveyed is very well-defined and interpreted by the packet server. Both messages in Koskinen's and Nasielski's convey an indication that is very well-defined to the intended party. The fact that both of these inventions use a different mechanism to carry out their messages does not imply that these inventions are not combinable.

Koskinen's invention at column 1 lines 30-33 discloses using packet-switch in addition to circuit-switch. This suggests that Koskinen's invention is very well suited for circuit-switch, which contradicts the Applicant's statement of Koskinen's invention of being far more complex for circuit-switch communication.

Nasielski was cited for transmitting a message from a mobile terminal to the server that handles the packet session over a circuit-switched channel after receiving an incoming call. The suspension of the packet session is disclosed by Koskinen's invention.

Therefore, the argued features are written such that they read upon the cited reference(s).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 2-5, 8, 9, 27, 29 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koskinen et al. (EP 1096813 A2), hereafter "Koskinen," in view of Nasielski et al. (US 20050041640 A1), hereafter "Nasielski."

Consider claim 2, Koskinen discloses a wireless terminal participating in a packet-switched communication session to provide notice of receipt of an incoming circuit-switched call, the method comprising: (see fig. 1a, col. 7 lines 28-32 and 56-58, col. 8 lines 1-13): receiving a paging request associated with the incoming circuit-switched call (see col. 7 lines 32-56); and notifying a server that establishes and runs the packet-switched communications session that the wireless terminal has received the incoming circuit switched call (see col. 7 line 58, col. 8 lines 1-13).

Koskinen, however, does not particular refer to wherein notifying the server that establishes and runs the packet-switched communications session with at the wireless terminal has received the incoming circuit switched call comprises forwarding a notification message from the wireless terminal to the server over a circuit-switched channel.

Nasielski, in the same field of endeavor, teaches transmitting a notification message from the wireless terminal to the server over a circuit-switched channel (**see pars. 0057 lines 1-6, 0066 lines 1-6** - Nasielski discloses a mobile terminal transmitting a reply via an SMS message to the network indicating whether the mobile station accepts or rejects an incoming call).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Koskinen and have it include transmitting a notification message from the wireless terminal to the server over a circuit-switched channel, as taught by Nasielski. The motivation would have been in order to facilitate the transmission of a message over a communication network that is widely preferable by network operators (**see pars. 0057 lines 1-6, 0066 lines 1-6**).

Consider claim 3, Koskinen as modified by Nasielski discloses the invention of claim 2 above. Koskinen also discloses wherein the incoming circuit-switched call comprises a circuit-switched call transmitted over a GSM network (see col. 1 lines 37-42, col. 6 lines 22-29). Nasielski also teaches wherein the circuit-switched channel is the SMS data bearer (see pars. 0057 lines 1-6, 0066 lines 1-6). The motivation would

have been in order to facilitate the transmission of a message over a communication network that is widely preferable by network operators (see pars. 0057 lines 1-6, 0066 lines 1-6).

Consider claim 4, Koskinen as modified by Nasielski discloses the invention of claim 3 above. Nasielski also teaches wherein the notification message comprises a text message (see pars. 0057 lines 1-6, 0066 lines 1-6). The motivation would have been in order to facilitate the transmission of a message over a communication network that is widely preferable by network operators (see pars. 0057 lines 1-6, 0066 lines 1-6).

Consider claim 5, Koskinen as modified by Nasielski discloses the invention of claim 3 above. Koskinen also discloses wherein the notification message is forwarded via an IP level connection over the SMS data bearer (see col. 1 lines 37-42).

Consider claim 8, Koskinen as modified by Nasielski discloses the invention of claim 2 above. Koskinen also discloses notifying the server that establishes and runs the packet-switched communications session upon termination of the incoming circuit-switched call (see col. 9 lines 41-47).

Consider claim 9, Koskinen as modified by Nasielski discloses the invention of claim 8 above. Nasielski also teaches wherein the notification forwarded upon termination of the incoming circuit-switched call is forwarded over a circuit-switched

channel (see pars. 0057 lines 1-6, 0066 lines 1-6). The motivation would have been in order to facilitate the transmission of a message over a communication network that is widely preferable by network operators (see pars. 0057 lines 1-6, 0066 lines 1-6).

Consider claim 27, Koskinen discloses a wireless communication terminal comprising: a transceiver; a packet-switched suspension notification circuit coupled to the transceiver that is configured to generate a notification message for transmission to a server controlling a packet-switched communications session when the wireless temporarily suspends participation in the packet-switched communications session (**see col. 7 line 58, col. 8 lines 1-13, col. 1 lines 37-42**); and a circuit-switched communications circuit, wherein the packet-switched suspension notification circuit generates the notification message in response to receipt of a circuit-switched page by the circuit-switched communications circuit (**see fig. 2a, col. 7 lines 56-58, col. 8 lines 1-13**).

Koskinen, however, does not particularly refer to a notification message that is suitable for transmission as a text message over a circuit switched SMS data bearer.

Nasielski, in the same field of endeavor, teaches a notification message that is suitable for transmission as a text message over a circuit switched SMS data bearer (**see pars. 0057 lines 1-6, 0066 lines 1-6** - Nasielski discloses a mobile terminal transmitting a reply via an SMS message to the network indicating whether the mobile station accepts or rejects an incoming call).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to modify the invention of Koskinen and have it include a notification message that is suitable for transmission as a text message over a circuit switched SMS data bearer, as taught by Nasielski. The motivation would have been in order to facilitate the transmission of a message over a communication network that is widely preferable by network operators (**see pars. 0057 lines 1-6, 0066 lines 1-6**).

Consider claim 29, this claim discusses the same subject matter as claim 27. Therefore, it has been analyzed and rejected based upon the rejection to claim 27.

Consider claim 36, Koskinen discloses a wireless terminal participating in a packet-switched communications session to provide notice of receipt of an incoming circuit-switched call, the method comprising (**see fig. 1a, col. 7 lines 28-32 and 56-58, col. 8 lines 1-13**): receiving a paging request associated with the incoming circuit-switched call (**see col. 7 lines 32-56**); notifying a server that establishes and runs the packet-switched communications session that the wireless terminal has received the incoming circuit-switched call (**see col. 1 lines 37-42, col. 7 line 58, col. 8 lines 1-13**); wherein the incoming circuit-switched call comprises a circuit-switched call transmitted over a GSM network (**see col. 1 lines 37-42, col. 6 lines 22-29**); forwarding a second notification message from the wireless terminal to the server that establishes and runs the packet-switched communications session upon termination of the circuit-switched call (**see col. 9 lines 41-47**).

Koskinen, however, does not particular refer to wherein notifying the server that

that establishes and runs the packet-switch communications session that the wireless terminal has received that incoming circuit-switched call comprises forwarding a first message from the wireless terminal to the server over the circuit-switched SMS data bearer channel and notifying a server is performed over a circuit switched SMS data bearer channel; forwarding a second notification message from the wireless terminal to the server that establishes and runs the packet-switched communications session via a text message

Koskinen, in the same field of endeavor, teaches notifying a server is performed over a circuit switched SMS data bearer channel; forwarding a notification message from the wireless terminal to the server via a text message (**see pars. 0057 lines 1-6, 0066 lines 1-6**).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Koskinen and have it include notifying a server is performed over a circuit switched SMS data bearer channel; forwarding a notification message from the wireless terminal to the server via a text message, as taught by Koskinen. The motivation would have been in order to facilitate the transmission of a message over a communication network that is widely preferable by network operators (**see pars. 0057 lines 1-6, 0066 lines 1-6**).

8. Claims 31, 32, 34, 37, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koskinen et al. (EP 1096813 A2), hereafter "Koskinen," in view of Nasielski et al. (US 20050041640 A1), hereafter "Nasielski," further in view of Levy et al.

(US 20040142694 A1), hereafter "Levy."

Consider claim 31, Koskinen as modified by Nasielski discloses the invention as in claims 2 and 36 above.

Koskinen, however, does not particular refer to wherein the packet-switched communication session comprises a push-to-talk session.

Levy, in analogous art, teaches a packet-switched communication session comprises a push-to-talk session (see pars. 0002 lines 1-5, 0011 lines 8-17, 0012 lines 1-2).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Koskinen as modified by Nasielski and have it include a packet-switched communication session comprises a push-to-talk session, as taught by Levy. The motivation would have been in order to inform users engaged in a communication session about a service interruption so that they can properly re-establish the session (see par. 0003 lines 9-21).

Consider claim 32, Koskinen as modified by Nasielski and Levy discloses the invention as in claim 31 above. Koskinen also discloses wherein notifying the server associated with the packet-switched communication session that the wireless terminal has received the incoming circuit-switched call includes notifying the server that wireless terminal has suspended the push-to-talk session (see col. 7 lines 56-58, col. 8 lines 1-13).

Consider claim 34, Koskinen as modified by Nasielski and Levy discloses the invention as in claim 32 above. Koskinen also discloses wherein the circuit-switched channel is the SMS data bearer (see col. 1 lines 37-42, col. 6 lines 22-29).

Consider claim 37, Koskinen as modified by Nasielski discloses the invention as in claim 36 above. Koskinen also discloses resuming the push-to-talk session under the existing Packet Data Protocol context after termination of the circuit-switched call (see col. 8 lines 3-7).

Koskinen, however, does not particular refer to wherein the packet-switched communications session comprises a push-to-talk session, wherein the server associated with the packet-switched communications maintains a Packet Data Protocol context associated with the push-to-talk session throughout the duration of the circuit switched call.

Levy, in analogous art, teaches wherein the packet-switched communications session comprises a push-to-talk session, wherein the server associated with the packet-switched communications maintains a Packet Data Protocol context associated with the push-to-talk session throughout the duration of the circuit switched call (see pars. 0019 lines 1-14).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Koskinen as modified by Nasielski and have it include wherein the packet-switched communications session comprises a push-to-talk session, wherein the server associated with the packet-switched communications

maintains a Packet Data Protocol context associated with the push-to-talk session throughout the duration of the circuit switched call, as taught by Levy. The motivation would have been in order to inform users engaged in a communication session about a service interruption so that they can properly re-establish the session (see par. 0003 lines 9-21).

Consider claim 38, Koskinen as modified by Nasielski and Levy discloses the invention as in claim 37 above. Levy also teaches notifying a remote wireless terminal that is part of the push-to-talk session that the wireless terminal has temporarily suspended participation in the push-to-talk session (see par. 0012 lines 17-22). The motivation would have been in order to inform users engaged in a communication session about a service interruption so that they can properly re-establish the session (see par. 0003 lines 9-21).

Allowable Subject Matter

3. Claims 6 and 39 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
4. Claim 40 is now allowed.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marcos Batista, whose telephone number is (571) 270-5209. The Examiner can normally be reached on Monday-Thursday from 8:00am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rafael Pérez-Gutiérrez can be reached at (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

/Marcos Batista/
Examiner

/Rafael Pérez-Gutiérrez/
Supervisory Patent Examiner, Art Unit 2617

06/01/2010